

REMARKS

Upon entry the present response, the claims will not have been amended. However, claim 53 and 54 will have been submitted for consideration. Accordingly, claims 35-54 will remain pending for consideration. In view the herein contained remarks, Applicant respectfully requests reconsideration and withdrawal of each of the outstanding objections and rejections set forth in the Official Action of August 16, 2006, together with an indication of the allowability of all the claims pending in the present application.

In the outstanding Official Action the Examiner withdrew claims 37-43, 45, 46, 51 and 52 from consideration pursuant to 37 C.F.R. § 1.142 (b) as being drawn to a nonelected invention. The Examiner noted that Applicant timely traversed the restriction requirement in the reply filed on June 2, 2006.

The Examiner noted Applicant's traverse but did not consider the same to be persuasive.

The basis for the Examiner's not finding Applicant's traverse persuasive appears to be related to his inability to find support for the invention as defined by the elected species in the original disclosure. As will be set forth more clearly below, support for Applicant's claimed invention is clearly contained in the present application.

The Examiner further asserts that species directed to a single embodiment can be restricted. Without delving into the truth or applicability of this statement, Applicant notes that the Examiner quotes "U.S.C. § 112 second paragraph". The Examiner then quotes various "limitations" of claims 45 and 46. However neither of the quoted limitations are found in Applicant's claims. In this regard claim 45 does not include the

limitation " the copy mode not to be switched" as asserted by the Examiner, nor is such terminology contained in claim 46. Further the Examiner asserted that claim 45 sets forth a limitation of "inhibiting starting printing". Applicant respectfully submits that claim 45 does not contain this limitation, nor does claim 46. Thus the Examiner's conclusion, that the traverse by Applicant's regarding "their inventions are different in different claims" is not relevant, because the Examiner has not accurately quoted the limitations of Applicant's claims.

Nevertheless, in spite of the Examiner's assertions Applicant respectfully submits that under the circumstances of the present application, in view of the claim limitations and the relationship between the various claims, restriction for examination purposes is inappropriate and thus accordingly again respectfully requests reconsideration and withdrawal of the restriction requirement and issuance of an action on the merits of all the claims pending in the present application.

In the outstanding official action the Examiner objected to the drawings under 37 C.F.R. § 1.83 (a). The Examiner asserted that the drawings must show every feature of the invention specified in the claims. The Examiner required that the limitation "when the numerical value input by the panel exceeds the display capacity of the screen in the copy mode, switches from the copy mode to the facsimile mode" be shown in the drawings. The Examiner also required a showing of the relationship of the new drawing with respect with Fig. 3.

Applicant traverses the above objection and submits that the drawings clearly show every feature of the invention specified in the claims. In this regard, Applicant respectfully directs the Examiner's attention to Fig. 2 of the present application wherein

a digits number counting section 21, a mode switching determination section 22, a mode determination section 23 and a mode switching section 24 are illustrated. The operation of the sections illustrated in Fig. 2 are explained beginning at the top of page 6 of the specification.

In particular, the mode switching determination section 22 is described as "for determining based on the counted number of digits whether or not to switch a mode". Moreover, in the paragraph beginning on page 6, line 20, the mode switching determination section 22 is described as determining "whether or not the number of digits in the input value exceeds a threshold value in order to determine whether or not to switch the mode". Further, in the paragraph beginning at page 7, line 6 Applicant's disclosure indicates that determining whether or not to switch the mode, the digits number section 21 counts the number of digits in a destination telephone number and the mode switching determination section 22 uses as a threshold value a numerical value smaller than a number of digits in the determination telephone number. For example, according to the teachings of the present invention, the threshold value for input digits is set at 2 to allow only 2 digits to be displayed.

Accordingly, it is respectfully submitted that the Examiner's objection is overcome by the showing of Fig. 2 and the description related thereto at pages 6 and 7 of Applicant's original specification. Accordingly, it is respectfully submitted that no new drawings are required.

In this regard, Applicant further notes that the embodiment recited in the claims currently being examined does not have a flow chart associated therewith. Applicant respectfully submits that a particular type of illustration i.e. utilizing a flow chart, is not a

requirement of 37 C.F.R. § 1.83 (a). Nevertheless, should the Examiner determine that a flow chart, consistent with the above-noted portion of the disclosure and explaining in detail the operation of the embodiment of the invention illustrated in Fig. 2 is necessary, the Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number. Applicant's representative will endeavor to provide the Examiner with an additional drawing sheet containing an appropriate flow chart. Nevertheless, Applicant respectfully submits that such flow chart is not necessary and accordingly Applicant traverses the Examiner's requirement and decline to provide a flow chart at this time.

In the outstanding Official Action the Examiner rejected claims 35, 36, 44, 47-50 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. The Examiner asserted that the claims contained subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In this regard, the Examiner quoted the last recitations of each of apparatus claim 35 and method claim 44. The Examiner asserted that these features were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention.

Applicant respectfully traverses the above rejection and submits that is inaccurate with regard to the present application. Applicant respectfully submits that each of the claims of the present application is based upon a disclosure which contains a description such that one ordinarily skilled in the art would have possession of the

claimed invention. In this regard, Applicant respectfully directs the Examiner's attention to pages 6 and 7 of the specification that were previously discussed in detail with respect to the outstanding objections to the drawings.

Additionally, the Examiner's attention is respectfully directed to the originally filed claims of Applicant's parent application, U.S. Patent Application 09/049,144, now U.S. Patent No. 6,137,598. In this regard, the Examiner attention is particularly directed to original claim 8 which recites, inter alia, input means for inputting the number of sheets to be copied, digits numbers counting means for counting the number of input digits and mode switching means for switching the mode based on the counted number of digit". Claim 11 recites, inter alia, "when the counted number of digits is smaller than a predetermined threshold value during the facsimile mode, the mode is switched to the copy mode". Claim 12 recites a display means showing "only" a number of digits the number of which is smaller than or equal to said threshold value during the copy mode. Accordingly Applicant respectfully submits that for this additional reason, the controller and the switching recited in claims 35 and 44 are clearly, adequately and sufficiently described and set forth in the written description of Applicant's invention. Thus, the subject matter of these claims is clearly described in the specification in such a way as to reasonably convey to one skilled in relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the outstanding rejections of any claims in the present application under 35 U.S.C. § 112.

In the outstanding Official Action the Examiner rejected all of the elected claims under 35 U.S.C. § 102 (b) as being anticipated by MATSUNAI (U.S. Patent No.

5,357,350). The Examiner asserted, *inter alia*, that MATSUNAI discloses a controller (PPC 2, column 6, lines 45-46) which, when the copy mode is set and when the numerical number value input by the panel section exceeds the display capacity of the screen IN the copy mode (STP 7, Fig. 4) switches from THE copy mode to a facsimile mode. Applicant respectfully traverses the above rejection and submits that the Examiner's characterization of the disclosure of the MATSUNAI reference, specifically with regard to the recited controller, is inaccurate and incorrect.

In particular, in Fig. 2a of MATSUNAI, the display capacity of the screen of the copy mode is showing to be three digits (i.e., "123"). On the other hand, STP6 in Fig. 4 clearly indicates that a change in mode takes place when the number of input digits is 5. Clearly then there is no direct relationship between the capacity of the screen in the copy mode and the switching from the copy mode to the facsimile mode. Rather, in MATSUNAI, the threshold number of digits is arbitrarily selected by the user, and has no direct relationship to the display capacity of the screen in the copy mode. Accordingly, it is respectfully submitted that the Examiner's rejection is inappropriate and should be withdrawn.

In setting forth the rejection in relation to claims 47 and 48, the Examiner asserts that MATSUNAI teaches that the controller is configured to switch to the facsimile mode in response to the numerical value exceeding the display capacity of the screen in the copy mode and refers to (STP 6, STP 7, Fig. 4). Again it is respectfully submitted that the Examiner is incorrect.

In this regard, Applicant's claim 47 explicitly recites that the switching is "in response to the numerical value exceeding the display capacity of the screen in the

copying mode". As previously pointed out there is no cause and effect relationship between the switching and the display capacity of the screen in MATSUNAI. Rather, the number of figures is arbitrarily selected to be less than the number of digits in a facsimile number. Accordingly, claims 47 and 48 are even more clearly patentable over the MATSUNAI reference relied upon by the Examiner because they define a feature of Applicant's claimed invention with enhanced specificity and clarity.

Nevertheless, Applicant's independent claims 35 and 44 which recite the switching "when the numerical value input by the panel exceeds the display capacity of the screen in the copy mode" is also clearly patentable over the MATSUNAI reference cited by the Examiner.

By the present response, Applicant has submitted claims 53 and 54 for consideration. These claims are submitted to be patentable over the cited reference.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections together with an indication of the allowability of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has again traversed the outstanding restriction requirement and requested the reconsideration thereof together with the examination on the merits of all the claims pending in the present application.

Applicant has discussed the Examiner's objections to the drawings and has traversed the same, providing the Examiner with explicit support for the features of Applicant's claims in the present application.

Applicant has further discussed the 35 U.S.C. § 112, first paragraph rejection and has traversed the same, directing the Examiner's attention to explicit portions of the specification which supports the recitations of the pending claims.

Applicant thus also discussed the Examiner's rejection on prior art grounds and has pointed out the shortcomings and deficiencies of the reference relied upon by the Examiner. In this regard, Applicant has compared the explicitly recited features of Applicant's claims with the disclosure of the reference and has pointed out the deficiencies of the references with a respect thereto. Accordingly, Applicant has provided a clear evidently basis for the patentability of the claims in the present application and respectfully requests an indication to such effect in due course.



Should an extension of time be necessary to maintain the pendency of this application, including any extensions of time required to place the application in condition for allowance by an Examiner's Amendment, the Commissioner is hereby authorized to charge any additional fee to Deposit Account No. 19-0089.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
Masanori KAMATA

A handwritten signature in black ink, appearing to read 'Bruce H. Bernstein', written over a horizontal line.

Bruce H. Bernstein  
Reg. No. 29,027

William Pieprz  
Reg. No. 33630

November 16, 2006  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191